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SONNENSCHN NATH & ROSENTHAL
P.O. BOX 061080
WACKER DRIVE STATION
CHICAGO, IL 60606-1080

EXAMINER

TSANG FOSTER, SUSY N

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 06/11/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/942,008	Applicant(s) HOSOYA ET AL.	
	Examiner Susy N Tsang-Foster	Art Unit 1745	

-- **Th MAILING DATE of this communication app ars on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The disclosure is objected to because of the following informalities: On page 2, in the first full paragraph, "elated" should be "intercalated".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by the CAPLUS abstract for Prosini et al. "Improved electrochemical performance of a LiFePO₄-based composite cathode", *Electrochimica Acta* (2001), 46(3), pp. 3517-3523.

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The CAPLUS abstract for Prosini et al. disclose a nonaqueous electrolyte cell comprising a lithium iron phosphate based composite cathode. The lithium iron phosphate was synthesized in the presence of 10 weight percent of a high surface area carbon black. The carbon black is a fine carbon powder that reduces the lithium iron phosphate grain size. The carbon is uniformly dispersed between the lithium iron phosphate grains. The discharge capacity is 170 mAh/g which is greater than that of any of applicant's examples in Tables 1 and 3 which indicates that the density of the cathode of Prosini et al. must be greater than 2.2 g/cm^3 since the same amount of carbon material is used in the cathode as that of applicants'.

5. Claims 1, 3, 5-9, 11-14, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Barker et al. (US 6,528,033 B1).

Barker et al. disclose a nonaqueous electrolyte cell having a cathode including a cathode active material with the formula LiFePO_4 and a carbon material with a carbon content of 4.7 weight percent based on a molecular weight of LiFePO_4 given as 157 g/mole and assuming complete reaction in example 1 producing 1 mol LiFePO_4 and 12 g of carbon and a powder density of 3.6 g/cm^3 (see Figure 1; col. 7, lines 45-53; and col. 14, lines 15-47; col. 18, lines 36-67). The nonaqueous cell also includes an anode including an anode active material, a nonaqueous electrolyte and a separator film and a nonaqueous solution based electrolyte (col. 7, lines 54-65). The separator can also be polymeric electrolyte (col. 13, lines 1-45).

The method of producing the cathode active material includes providing the starting materials in particle form that comprise of a lithium containing compound, one or more metal containing compounds, a compound capable of providing the phosphate anion, and carbon

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powder (col. 3, lines 61-67). The starting materials are mixed together with carbon such that the carbon is intimately mixed with the product active material (col. 4, lines 4-25). The starting materials are mixed and dry ground with a ball mill for about 30 minutes and pressed into a pellet (col. 4, lines 30-35) before sintering (heating) the material from 750 to 800 °C in a non-oxidizing atmosphere (col. 6, lines 5-17 and col. 11, lines 5-34).

It is noted that applicants of the present invention added 3 weight % of acetylene black powders based on the entire weight of the fired product (see page 20 of applicant's specification). It is noted that in Barker et al., the carbon material is 6 weight percent of the entire weight of the starting product mixture that is fired which is 100% excess of the carbon used (see col. 14, lines 15-46) such that the fired product must contain at least 3 weight percent carbon (corresponding to the 100% excess).

The cathode prepared contains 85% by weight of active material, 10% by weight percent carbon black, and 5 % by weight binder (col. 18, lines 36-67). It is noted that carbon black is also added to the fired product.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4, 10, and 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barker et al. (US 6,528,033 B1).

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Barker et al. disclose all the limitations for claims 2, 4, 10, and 15 except explicitly disclosing that the carbon material in the cathode is a material that has a Raman spectrum characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak respectively is greater than or equal to 0.30.

It is noted that the carbon material of Barker et al. was subjected to heating and grinding (ball milling) in the method of making the cathode material as stated above. The carbon material of the prior art was ground by ball milling and sintered at 750 to 800 C which is similar to the conditions under which the carbon material was treated in applicants' invention as disclosed on page 20 and 21 of the specification. It is noted that applicants added 3 weight % of acetylene black powders based on the entire weight of the fired product (see page 20 of applicant's specification). It is noted that the carbon material is 6 weight percent of the entire weight of the starting product mixture that is fired which is 100% excess of the carbon used (see col. 14, lines 15-46) such that the fired product must contain at least 3 weight percent carbon (corresponding to the 100% excess). Therefore, the carbon material that is sintered in the cathode material of Barker et al. inherently has a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30. The initial discharge capacity of the battery of Barker et al. is 121 mAh/g (see Figure 2 and col. 19, lines 5-26) which is comparable to the values of the initial discharge capacity of the battery of the instant invention when the ratio of A as defined in the instant claims is greater than 0.3 (see Table 3, page 39 of applicants' specification). Since the same electrode active material is used, the same amount of

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carbon, and the same density of the active material is used, and similar discharge capacity is obtained by the battery containing the cathode active material of Barker et al. , the carbon material in the cathode of Barker et al. including the carbon black added to the active material is expected to have a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30.

The court has held that claiming of a property or characteristic which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP 2112 and 2112.01. When the Examiner has provided a sound basis for believing that the products of the applicant and the prior art are the same, the burden of proof is shifted to the applicant to prove that the product shown in the prior art does not possess the characteristics of the claimed product. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 09/969,220 in view of Barker et al. (US 6,528,033 B1).

Claim 6 of copending application recites a nonaqueous electrolyte cell comprising a LiFePO_4 carbon composite material as a cathode active material; an anode including an anode active material; a nonaqueous electrolyte solution, and the powder density of the LiFePO_4 carbon composite material is not less than 2.2 g/cm^3 .

Claim 6 of the copending application does not recite that the carbon material in cathode active material is not less than 3 w%, and that the carbon material satisfies the condition that the ratio of peak area appearing from 1350 cm^{-1} to 1360 cm^{-1} to the peak area appearing from 1570 cm^{-1} to 1590 cm^{-1} in the Raman spectrum is greater than or equal to 0.30.

Barker et al. teach a battery comprising a cathode comprising 85 wt% LiFePO_4 , 10% by weight carbon black and 5% by weight binder where the carbon black inherently has a Raman spectrum characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 for reasons give above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 10% by weight carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 to the cathode recited in claim 6 of the copending application because this amount of carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak

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at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 is effective for increasing the electrical conductivity of the cathode which improves battery performance.

10. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 09/972,375 in view of Barker et al. (US 6,528,033 B1).

The difference between claim 9 of the copending application and instant claims 1- 6 is that claim 9 of the copending application does not recite that the carbon material in cathode active material is not less than 3 w%, and that the carbon material satisfies the condition that the ratio of peak area appearing from 1350 cm^{-1} to 1360 cm^{-1} to the peak area appearing from 1570 cm^{-1} to 1590 cm^{-1} in the Raman spectrum is greater than or equal to 0.30.

Barker et al. teach a battery comprising a cathode comprising 85 wt% LiFePO_4 , 10% by weight carbon black and 5% by weight binder where the carbon black inherently has a Raman spectrum characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 for reasons give above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 10% by weight carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30. to the cathode recited in claim 9 of the copending application because this amount of carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak

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at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 is effective for increasing the electrical conductivity of the cathode which improves battery performance.

This is a provisional obviousness-type double patenting rejection.

11. Claims 7-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 10 of copending Application No. 09/961,895 in view of Barker et al. (US 6,528,033 B1).

The difference between claims 4 and 10 of the copending application and instant claims 7-15 is that claims 4 and 10 of the copending application does not recite that the carbon material in cathode active material is not less than 3 w%, and that the carbon material satisfies the condition that the ratio of peak area appearing from 1350 cm^{-1} to 1360 cm^{-1} to the peak area appearing from 1570 cm^{-1} to 1590 cm^{-1} in the Raman spectrum is greater than or equal to 0.30.

Barker et al. teach a battery comprising a cathode comprising 85 wt% LiFePO_4 , 10% by weight carbon black and 5% by weight binder where the carbon black inherently has a Raman spectrum characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 for reasons give above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 10% by weight carbon black having a Raman spectrum that is characterized by

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having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30. to the cathode recited in claims 4 and 10 of the copending application because this amount of carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 is effective for increasing the electrical conductivity of the cathode which improves battery performance.

This is a provisional obviousness-type double patenting rejection.

12. Claims 1-6 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 09/972,395 in view of Barker et al. (US 6,528,033 B1).

The difference between claim 9 of the copending application and instant claims 1-6 is that claim 9 of the copending application does not recite that the carbon material in cathode active material is not less than 3 w%, and that the carbon material satisfies the condition that the ratio of peak area appearing from 1350 cm^{-1} to 1360 cm^{-1} to the peak area appearing from 1570 cm^{-1} to 1590 cm^{-1} in the Raman spectrum is greater than or equal to 0.30.

Barker et al. teach a battery comprising a cathode comprising 85 wt% LiFePO_4 , 10% by weight carbon black and 5% by weight binder where the carbon black inherently has a Raman spectrum characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1}

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such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 for reasons give above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 10% by weight carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30. to the cathode recited in claim 9 of the copending application because this amount of carbon black having a Raman spectrum that is characterized by having a peak at 1350 to 1360 cm^{-1} and a peak at 1570 to 1590 cm^{-1} such that the ratio of the peak area of the first peak to the peak area of the second peak is greater than or equal to 0.30 is effective for increasing the electrical conductivity of the cathode which improves battery performance.

This is a provisional obviousness-type double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (703) 305-0588. The examiner can normally be reached on Monday through Thursday from 9:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (703) 308-2383. The phone number for the organization where this application or proceeding is assigned is (703) 305-5900.

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The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9310 for regular communications and (703) 872-9311 for After-Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

st/7 June 2003

Ausy Isany Foster